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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,981	07/31/2003	George Martinez	612-11-PA	2212
22145	7590	09/21/2006	EXAMINER	
KLEIN, O'NEILL & SINGH, LLP 43 CORPORATE PARK SUITE 204 IRVINE, CA 92606			ADAMS, AMANDA S	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,981	<b>Applicant(s)</b> MARTINEZ, GEORGE	
	<b>Examiner</b> Amanda Adams	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/14/03, 4/10/03, 10/29/03, 10/20/03</u>                                 | 6) <input type="checkbox"/> Other: _____                                    |

ASA

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1-39 of this application conflict with claims 1-10 and 13-25 of Application No. 11/089207. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 recites the limitation "the openings" in lines 10. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3731

4. Claims 1-3, 5-7, 14-18, 20-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (US 6,723,108).

5. Jones et al disclose the invention substantially as claimed including an elongate flexible inner element ([20] and col. 5, lines 13-16), a non metallic intermediate element surrounding and in intimate contact with the inner element ([22]), and an outer element coaxially surrounding and in intimate contact with the intermediate element defining a gap or opening through which the intermediate element is exposed ([12]). Jones et al disclose that the inner element is composed of a biocompatible material that is either metal wire or a polymeric filament (col.5, lines 21-25) and has a coupling element on the proximal end (col. 5, lines 18-20), and the intermediate element includes an expansile polymeric material that consists of a hydrogel that includes either a therapeutic compound or a bioactive agent (col. 5, lines 50-56).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,723,108) in view of Dutta (US 6,623,450).

Art Unit: 3731

8. Jones et al disclose the invention substantially as claimed above but fail to disclose the environmental parameter consisting of either temperature or pH. However, Dutta teaches that it is old and well-known in the art for a hydrogel to expand in response to a change in either temperature or pH (col. 2, lines 26-35). These are both parameters that define differences between blood and its surrounding environment. Therefore it would have been obvious to have a hydrogel that expands under these conditions as the intermediate layer so that it expands only when it is supposed to, that is when it recognizes the temperature or the ph of intravascular blood.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,723,108) in view of Sepetka et al (US 6,849,081) and further in view of Dutta (US 6,623,450).

10. Jones et al in view of Sepetka teach the invention substantially as claimed above but fail to disclose the environmental parameter consisting of either temperature or pH. However, Dutta teaches that it is old and well-known in the art for a hydrogel to expand in response to a change in either temperature or pH (col. 2, lines 26-35). These are both parameters that define differences between blood and its surrounding environment. Therefore it would have been obvious to have a hydrogel that expands under these conditions as the intermediate layer so that it expands only when it is supposed to, that is when it recognizes the temperature or the ph of intravascular blood.

***Allowable Subject Matter***

Art Unit: 3731

11. Claims, 4, 9, 19, 10-13, 24, 25-28, and 36-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

1. Claims 29-34 are allowed. None of the cited references disclose or fairly suggest the limitations of claims 29-34, in particular the limitation of the intermediate element expanding between the open wound coils of the outer element.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Adams whose telephone number is (571) 272-5577. The examiner can normally be reached on M-F, 8:00am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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GLENN K. DAWSON  
PRIMARY EXAMINER